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PATENT

3621 2161 2765

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Ronald Lesser

Serial No.: 09/157,998

Art Unit: 2765

Filed: September 22, 1998

Examiner: Jeanty, Romain

For: A SOFTWARE DEVICE TO FACILITATE CREATION OF MEDICAL RECORDS,  
MEDICAL LETTER, & MEDICAL INFORMATION FOR BILLING PURPOSES

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**GROUP 3600**

**RESPONSE TO ELECTION REQUIREMENT**

Sir:

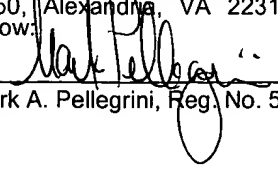
This communication responds to the Examiner's restriction requirement of April 16, 2004.

Among other things, that restriction requirement indicated that inventions I, II, and III (as detailed below) are related as sub-combinations disclosed as usable together in a single combination and imposed a restriction to one of the following inventions (under 35 U.S.C. 121):

- I. Claims 49-50, 76-77, 81, and 88, drawn to an apparatus for gathering medical information regarding a patient and generating a billing code related to that information.

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Mark A. Pellegrini, Reg. No. 50,233 April 22, 2004  
DATE

Claims 51-54, 78, 82, 85, and 89, drawn to a method for gathering a patient's data and subsequently generating a billing code.

Claims 57, 79, 87, and 90, drawn to a method for an integrated electronic system for conducting a medical interview of a patient and contemporaneously calculating an appropriated government billing code based on that interview.

- II. Claims 55-56, 58-67, 74, 80, 84, 86, and 91-93, drawn to a method of calculating a medical billing code that complies with the requirements of the USHCFA.
- III. Claims 68-73, 75, and 83, drawn to an apparatus for compiling medical data and generating claims consistent with payer mandates.

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Subject to the remarks herein, Applicant provisionally elects Group I with corresponding Claims 49-54, 57, 76-79, 81-82, and 87-90 for examination.

**A. CLARIFICATION OF RESTRICTION REQUIREMENT**

First, Applicant respectfully requests clarification of the Examiner's restriction requirement. In this regard, Applicant is uncertain of the basis used by the Examiner in grouping claims to the allegedly different sub-combinations.

For example, the restriction requirement asserts that Claims 57, 79, 87 and 90 are drawn to "a method." However, the plain language of those claims shows that they are each apparatus claims. The Group II claims (consisting of Claims 55-56, 58-67, 74, 80, 84, 86, and 91-93) similarly are indicated as being drawn to "a method." However, of those Group II claims, only Claims 55 and 56 are "method" claims.

Especially to the extent that this may affect the imposition of any restriction requirement at all, or at least the claim groupings that result from any such restriction requirement, Applicant respectfully requests clarification of same.

**B. GROUP II APPARENTLY SHOULD BE COMBINED INTO GROUP I**

Second, the Examiner indicates that the Group I claims are classified in Class 705, subclass 2 (which subclass relates to “billing systems based on entered medical codes, for example ICDA codes (International Classification of Disease Abstracted)”), and that the Group II claims are classified in Class 705, subclass 3 (Patient Record Management). However, Applicant notes that the Group II claims relate to *calculating a medical billing code* that complies with the requirements of the USHCFA. Accordingly, if the Examiner’s grouping scheme for the alleged sub-combinations is based on the USPTO classification system, Applicant respectfully submits that the Group II claims (Claims 55-56, 58-67, 74, 80, 84, 86, and 91-93) should be combined with the Group I claims, as they appear to be more appropriately related to the PTO’s subclass 2 than subclass 3.

Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction requirement of Group II and include those claims with Applicant’s elected Group I. As explained herein, the resulting elected “Group I” claims should therefore include at least Claims 49-67, 74, 76-82, 84-93.

**C. ALLOWABILITY OF CLAIMS IN EACH GROUP, AS INDICATED IN PREVIOUS OFFICE ACTION**

Third, the Examiner has previously indicated that claims are allowable from each of the restricted claim groups. Applicant respectfully requests clarification of the impact of the subsequent restriction requirement on those already “allowable” claims.

Among other things, because the Examiner has now imposed a restriction requirement, it appears that Applicant will be foreclosed from issuing in this application certain “unelected” claims that have already been examined and indicated allowable (and will be forced to the burden and expense and delay of pursuing same, if at all, through a divisional or similar application). That result seems not only unfair to Applicant but to be a waste of the PTO’s time and resources.

More specifically, in the Office Action dated May 21, 2002, the Examiner indicated the allowability of independent Claims 51, 55, 57, 58, 59, and 68, and their dependent claims if written to overcome the Section 112, second paragraph rejection. Applicant amended those claims to overcome the Section 112 rejection in a response dated November 21, 2003. No further amendments relating to those or any other claims has occurred subsequent to the November 21, 2003 response.

Accordingly, some of those “indicated allowable” claims are in each of the Examiner’s Groups I, II, and III. For example, allowable Claims 51-54, 57, 77-79, 82, 85, 87, and 89-90 are in elected Group I; allowable Claims 55-56, 58-67, 80, and 84 are in non-elected Group II; and allowable Claims 68-73 and 83 are in non-elected Group III.

At the very least, of the present elected “Group I” claims, Applicant submits that Claims 51-54, 57, 77-79, 82, 85, 87, and 89-90 are now in condition for allowance. However, as indicated above, if the Examiner agrees that the Group I and II claims should be combined, Applicant submits that at least Claims 51-67, 77-82, 84-85, 87, and 89-90 are now in condition for allowance.

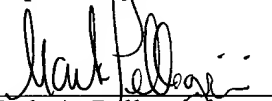
Further in this regard, even some of the clearly allowable Group I claims are problematic, in that they are multiple dependent claims depending on claims in both Group I and Group II (see, for example, Claims 77 and 81. If the Examiner agrees with Applicant’s foregoing remarks

(that Group II should be combined with Group I), this issue should be resolved. Depending of the Examiner's final disposition of the Group II claims, however, Applicant authorizes the Examiner to amend, if needed, the appropriate Group I multiple dependent claims to address that multiple dependency on Group II). In that regard, Applicant expressly reserves the right to pursue in a subsequent application any such "non-elected" claims that result from any such Examiner's amendment.

If the Examiner has any questions or would like to discuss any remaining or new issues regarding this communication, Applicant invites the Examiner to contact the undersigned representative of Applicant at (949) 718-6750.

Please acknowledge receipt of this document on the enclosed postal card.

Respectfully submitted,



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Date: April 22, 2004

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